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EXAMINER

HENEGHAN, MATTHEW E

| ART UNIT | PAPER NUMBER |
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2134

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

1. In response to the previous office action, Applicant has amended claims 1, 3, 6, 7, 9, 10, 15, 27, and 42 and added claims 72-87. Claims 1-51 and 72-87 have been examined.

Oath/Declaration

2. In view of the resubmission of an oath signed by Inventor Daniel T. Brown, the previous objection to the oath/declaration has been withdrawn.

Specification

3. In view of Applicant's amendments to the specification, all previous objections to the specification are withdrawn.

Claim Rejections - 35 USC § 112

4. In view of Applicant's amendments, all previous rejections under 35 U.S.C. 112 are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 4-6, 8, 10, 12, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,223,190 to Aihara et al.

As per claims 1, 2, and 4, a flash disk is used as a removable medium to transfer generated HTML program code from a device to a computer (see column 5, lines 55-57 and column 9, lines 27-39).

As per claims 5 and 6, the HTML program generates references to accompanying images which are retrieved by using the HTML program (see column 7, lines 22-25).

As per claim 8, HTML is a hardware-independent language.

As per claim 10, the HTML program and the accompanying images are stored in different files, thus constituting partitions.

As per claim 12, Aihara discloses an image viewer.

As per claim 18, a flash disk is composed of semiconductor memory cells.

6. Claims 20, 22, 23, 25, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,523,117 to Oki et al.

As per claims 20, 23, Oki discloses the use of a removable medium such as a memory stick (though it is described throughout the specification in terms of a CD-ROM), which is a solid-state (see column 1, line 40). The information on the medium is retrieved and decrypted using a key retrieved using, in part, the "CD number," which is the identifier associated with the device (see column 6, lines 22-54), which must necessarily have been stored on the medium. The retrieved material may be software (i.e. program code) (see column 1, lines 14-20).

Regarding claim 22 and 25, after a transaction is begun, the instructions for providing the code and identifier inherently execute automatically.

Regarding claim 35, a memory stick comprises semiconductor cells.

7. Claims 76, 77, 80-82, and 85-87 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,478,222 to Sarfati.

As per claim 76, 81, Sarfati discloses an MPEG player in a digital decoder wherein MPEG (audio/video) files and other applications are stored within a smartcard

Art Unit: 2134

and downloaded to the decoders, and used together to display a transmission (see column 7, lines 10-31).

As per claim 77, 82, the use of Java is disclosed (see column 6, lines 26-33).

As per claim 80, 85, ROM (read-only memory) may be used (see column 4, line 2).

Regarding claims 86 and 87, MPEG can be used for still pictures or sequences of images.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claim 8 above, and further in view of U.S. Patent No. 6,481,632 to Wentker et al.

Aihara only discloses the use of HTML with the smartcard.

Wentker discloses the use of Java, and suggests that this is a suitable Smartcard operating system (see column 6, lines 44-46).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to further modify the invention of Aihara by using Java applications, as disclosed by Wentker, as this is a suitable Smartcard operating system.

9. Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claims 10 and 17 above, and further in view of U.S. Patent No. 6,766,417 to Tanaka et al.

Aihara does not disclose the layout of the memory with respect to persistent data storage.

Tanaka the writing of application data stored in a buffer being written to a flash ROM that is organized by pages, which do not change during normal operation; the area is therefore fixed (see column 5, lines 19-23 and column 6, lines 15-18) and only available on the solid-state memory device, and notes that when a read write control program for the information processing unit is developed for a flash ROM (write-once memory cells) of a specific capacity, a flash ROM of some other capacity becomes unable to be utilized by the program (see column 1, lines 40-44).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara by writing application data to pages of a flash ROM, as disclosed by Tanaka, because when a read write control program for the information processing unit is developed for a flash ROM of a specific capacity, a flash ROM of some other capacity becomes unable to be utilized by the program.

10. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claim 6 above, and further in view of U.S. Patent Application Publication No. 2002/0161709 to Floyd et al.

Aihara does not disclose the time limits or usage limits of programs on the smartcard.

Floyd discloses a content delivery system wherein product use can be either for a time period or a number of uses (see paragraph 22) and suggests that this reduces piracy by not making it fully useful to a customer until it is "purchased."

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara by allowing product use for either a time period or a number of uses, as disclosed by Floyd, as this reduces piracy by not making it fully useful to a customer until it is "purchased."

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claims 1 and 6 above, and further in view of U.S. Patent No. 5,835,396 to Zhang.

Aihara does not disclose the structure of the memory used in the flash disk.

Zhang discloses the organization of memory in a three-dimensional array (see abstract) and suggests that this allows for increased memory density (see column 1, lines 65-67).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara by using flash disks having three-dimensional memory arrays, as disclosed by Zhang, to have increased memory density.

12. Claims 26, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,523,117 to Oki et al. as applied to claims 20 and 23 above, and further in view of U.S. Patent No. 6,478,222 to Sarfati.

Oki does not disclose the languages and formats of applications.

Sarfati discloses a smartcard that delivers Java programs and MPEG (audio/video) streams (see column 4, lines 14-20 and column 6, lines 26-33) and suggests that this is advantageous because the use of these languages also allows for the use of broadcast communications (see column 2, line 66 to column 3, line 7).

Therefore it would have obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Oki by supporting Java and MPEG applications on the memory stick, as disclosed by Sarfati, to allow for the use of broadcast communications.

13. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,523,117 to Oki et al. as applied to claims 20 and 23 above, and further in view of U.S. Patent Application Publication No. 2002/0161709 to Floyd et al.

Oki does not disclose a limitation on the time period or number of uses from the device.

Floyd discloses a content delivery system wherein product use can be either for a time period or a number of uses (see paragraph 22) and suggests that this reduces piracy by not making it fully useful to a customer until it is "purchased."

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Oki by allowing product use for either a time period or a number of uses, as disclosed by Floyd, as this reduces piracy by not making it fully useful to a customer until it is "purchased."

14. Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,523,117 to Oki et al. as applied to claims 20 and 23 above, and further in view of U.S. Patent No. 5,835,396 to Zhang.

Regarding claim 34, Oki does not disclose the structure of the memory used in the memory stick.

Zhang discloses the organization of memory in a three-dimensional array (see abstract) and suggests that this allows for increased memory density (see column 1, lines 65-67).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Oki by using memory sticks having three-dimensional memory arrays, as disclosed by Zhang, to have increased memory density.

Regarding claim 36, Oki suggests several types of media for storage, such as CD-ROM or memory stick. Since Oki discloses both the memory media and write-once

media in this group, one skilled in the art would recognize that a write-once memory would also be a choice for the storage medium.

15. Claims 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claims 1 and 6 above, and further in view of U.S. Patent No. 6,478,222 to Sarfati.

Aihara does not disclose the use of audio/video formats.

Sarfati discloses a smartcard that delivers MPEG (audio/video) streams (see column 4, lines 14-20 and column 6, lines 26-33) and suggests that this is advantageous because the use of these languages also allows for the use of broadcast communications (see column 2, line 66 to column 3, line 7).

Therefore it would have obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara by supporting MPEG applications on the flash disk, as disclosed by Sarfati, to allow for the use of broadcast communications.

16. Claims 78 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,478,222 to Sarfati as applied to claims 76 and 81 above, and further in view of U.S. Patent No. 6,766,417 to Tanaka et al.

Sarfati does not disclose the layout of the memory with respect to persistent data storage.

Tanaka the writing of application data stored in a buffer being written to a flash ROM that is organized by pages, which do not change during normal operation; the area is therefore fixed (see column 5, lines 19-23 and column 6, lines 15-18) and only available on the solid-state memory device, and notes that when a read write control program for the information processing unit is developed for a flash ROM (write-once memory cells) of a specific capacity, a flash ROM of some other capacity becomes unable to be utilized by the program (see column 1, lines 40-44).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Sarfati by writing application data to pages of a flash ROM, as disclosed by Tanaka, because when a read write control program for the information processing unit is developed for a flash ROM of a specific capacity, a flash ROM of some other capacity becomes unable to be utilized by the program.

17. Claims 79 and 84 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,6478,222 to Sarfati as applied to claims 76 and 81 above, and further in view of U.S. Patent No. 5,835,396 to Zhang.

Sarfati does not disclose the structure of the memory used in the smartcard.

Zhang discloses the organization of memory in a three-dimensional array (see abstract) and suggests that this allows for increased memory density (see column 1, lines 65-67).

Art Unit: 2134

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Sarfati by using smartcards having three-dimensional memory arrays, as disclosed by Zhang, to have increased memory density.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 1-7, 10, 11, 15, 17-19, 37-40, 43, 44, and 49-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 6, 8, 10, 11, 14, and 19-22 of U.S. Patent No. 6,778,974 to Moore et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '974 patent teaches to interfacing with a memory device comprising memory cells of a semiconductor material (see '974 patent, claim 20). It is well-known in the art to implement such memory as a solid-state device. All other limitations are presented in the claims of the '974 patent.

Allowable Subject Matter

19. Claims 37 and 39 would be allowable if rewritten or amended to overcome the rejections under double patenting set forth in this Office action.

20. Claims 16, 21, 24, 28, 29, and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

21. Claims 3, 7, and 15 would be allowable if rewritten to overcome the rejections under the doctrine of double patenting set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

22. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 3, 7, 15, 37, and 39, no art could be found that suggested the loading of program code from a memory device that would only store additional data on the device. Such programs commonly reside on the memory device and are never downloaded to the host device for execution there.

Regarding claims 16, 21, 24, 28, 29, and 33, though art is cited that loads program code for performing memory device program reading/writing and which loads

Art Unit: 2134

code for decryption of such code using the medium's identifier, the respective citations are non-analogous and there would be no motivation to combine the two for this purpose.

Claims 38 and 40-51 would be allowable based upon their dependence upon allowable claims.

Response to Arguments

23. Regarding claims 1 and 6, Applicant's arguments filed 2 August 2005 have been fully considered but they are not persuasive.

The only means by which Aihara suggests that a data file may be retrieved from the memory device is by way of the associated HTML file, which has been downloaded to the host device. HTML programs do not contain image files themselves, but rather references to the image files stored separately. In the example presented below column 12, an associated image file ("logo.gif") is designated as being stored in the same location as the HTML file in line 14. The HTML file loaded to the host device therefore loads the image file when it is run on the host device.

24. Applicant's arguments, see Remarks, filed 2 August 2005, with respect to the rejection(s) of claim(s) 20 and 23 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Oki.

25. Applicant's arguments, see Remarks, filed 2 August 2005, with respect to claims 37 and 39 have been fully considered and are persuasive. The art rejections of claims 37 and 39 have been withdrawn, though a double patenting rejection has now been made.

Conclusion

26. Due to the new grounds of rejection presented, this action is non-final.

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,808,111 to Kashef et al. discloses the use of smartcard applications at a terminal.

U.S. Patent No. 6,513,719 to Imura disclose the encrypting of programs stored in a memory stick.

U.S. Patent No. 6,779,115 to Naim discloses the storing of music on a smartcard.

U.S. Patent No. 6,308,317 to Wilkinson et al. discloses the storing of applications in a smartcard.

U.S. Patent No. 6,385,723 to Richards discloses a multi-application IC card.

U.S. Patent Application Publication No. 2003/0221113 to Kupka et al. discloses the storing of encrypted applications on a removable medium.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/775,745

Page 17

Art Unit: 2134

MEH *MEH*

October 31, 2005

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